

Appln No.: 09/869,365
Amendment Dated: December 3, 2004
Reply to Office Action of June 3, 2004

REMARKS/ARGUMENTS

This is in response to the Office Action mailed June 3, 2004 for the above-captioned application. Reconsideration and further examination are respectfully requested.

Applicants request an extension of time to make this paper timely, and enclose the fee. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 15-0610.

Claim 32 has been amended to correct a typographical error therein contained.

Claims 18-21, 24, 26-29, 32, and 36 stand rejected as being obvious under 35 USC section 103(a) over Haas et al. (US Patent No. 4,407,849) in view of Aikawa et al. (US Patent No. 5,296,011). With regard to these claims, the Examiner cites Haas as disclosing a gas discharge tube comprising at least two electrodes and at least one hollow insulator, wherein the chemically inert surface has been arranged onto the electrodes using graphite as a coating material. As the Examiner acknowledged in the rejection of the claims as obvious, Haas fails to disclose that the chemically inert surface being applied to the electrodes may be applied using a physical vapour deposition (PVD) or a chemical vapor deposition (CVD). The Examiner cites Aikawa to overcome this deficiency. Applicants respectfully traverse this rejection.

As a first matter, Aikawa is non-analogous art, being drawn from an entirely different technology. As explained by the Court of Appeals for the Federal Circuit in *In re Deminski*, 230 USPQ 313 (Fed. Cir. 1986),

The determination that a reference is from a nonanalogous art is therefore two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved.

Aikawa for discloses the formation of a chemically inert carbon coating on an optical fiber surface by a CVD process to provide a hermetically sealed optical fiber. It has nothing to do with surge arrestors. Thus, it is not within the inventor's field of endeavor. The inquiry must be therefore made as to whether it is reasonably pertinent to the particular problem.

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The problem which the present invention addresses is the formation of a gas discharge tube that exhibits higher selectivity, and better performance than prior art gas discharge tubes. Aikawa relates to hermetic coatings on optical fibers. The Haas surge arrestor patent and Aikawa are classified separately with no common classes listed in either the classification or field of search. The Examiner has not identified any recognized relationship between these technologies. Thus, the Examiner has not indicated how this would be deemed pertinent to gas discharge tubes, nor do Applicants believe that such a showing can be made. As such, Aikawa should be considered as nonanalogous art that cannot be relied upon, and the rejection should be withdrawn.

The second problem with the Examiner's argument is the lack of motivation in the references to combine the teachings. In order for a combination of references to be proper, there must be a suggestion in the references for such combination. "[O]bviousness is tested by what the combined teachings would have suggested ... but it cannot be established by combining teachings ... absent some teaching or suggestion supporting the combination." *In re Fine*, 5 USPQ 2d 1596 (Fed. Cir. 1988). Further, "Citing references which merely indicate the isolated elements ... are known is not a sufficient basis for concluding that the combination of elements would have been obvious." *Ex Parte Hiyamizu*, 10 USPQ 2d 1393 (POBAI 1988).

In the present case, this means that the Examiner would need some reason other than the present invention to take the CVD coating process of Aikawa and use it in a surge arrestor of Haas. Since Aikawa does not relate to surge arrestors, Applicants assume that the Examiner is arguing that the motivation is found in the statement in Aikawa that CVD coating "is advantageous in terms of coating speed as well as quality of the deposited layer." For this statement to be relevant, however, the Examiner must take into account what Aikawa was comparing CVD to, and establish that the definition of "quality coating" is the same for hermetic coatings on the outside of optical fibers and electrode coatings in surge arrestors. The Examiner has addressed neither of these issues, and therefore has failed to make a case of *prima facie* obviousness. Furthermore, it is noted that the problem that Aikawa overcomes is coating of the

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inside of the reactor used in the prior art. (See Aikawa Example 1) The Examiner has not indicated why this problem would have presented itself in the context of Haas, and thus provided no reasons to make the proposed combination of references.

Furthermore, even if a case of *prima facie* obviousness had been established, the Examiner must still consider secondary factors in determining obviousness. The properties of the present surge arrester are unexpected and are superior to the surge arresters of the prior art. Nothing in the references suggests that the use of CVD would achieve this result. Moreover, the Examiner, who is presumed to be skilled in the art and who is charged with the duty of determining the level of skill therein, himself rejected the claims of this application in previous Office Actions arguing that it didn't matter how the carbon layer was deposited onto the surge arrester and that since CVD and PVD methods were known that the present claims were obvious. See July 18, 2003 Office Action. Applicants thereafter provided Examiner with a declaration proving that Examiner's assumption and argument was in fact incorrect. Applicants argued and continue to argue that the method of depositing carbon onto the electrodes of a surge arrester *is* extremely important and that the surge arrester of the present invention provides unexpected and superior properties which are different than those of the prior art. Applicants resubmit this declaration as Annexure A for the convenience of the Examiner, and submit that it must be considered in assessing obviousness.

Examiner also rejected claims 22-23, 25, 30-31, and 33-34 under 35 USC § 103(a) as being unpatentable over Haas, Aikawa, and further in view of Lemelson (US 5349265). It is believed that Lemelson does not provide a teaching that overcomes the aforementioned deficiencies of the combination of Haas and Aikawa. Thus, this rejection should also be withdrawn.

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For these reasons, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

A handwritten signature in cursive script, appearing to read "Marina T. Larson", followed by a horizontal line.

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Annexure A